

REMARKS

INTRODUCTION:

In accordance with the foregoing, the specification and claims 23 and 39 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-39 are pending and under consideration.

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response because:

(a) the amendment of claims 23 and 39 (the amendment of claim 39 is merely a punctuation correction) should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and

(b) the amendments do not significantly alter the scope of the claims, and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

ALLOWABLE SUBJECT MATTER:

In the Office Action, at page 6, the Examiner indicated that claims 5-29 and 31-37 would be allowable if rewritten in independent form (and the rejection under 35 U.S.C. §112 is overcome). Applicant holds rewriting of these claims in abeyance until the Examiner has had the opportunity to review the arguments presented herein.

CHANGES TO THE SPECIFICATION:

The specification has been reviewed in response to this Office Action. Changes have been made to the specification to place it in preferred and better U.S. form for issuance. No new matter has been added.

Applicants respectfully submit that support for the phrase "monitor body" can be found, for example, in paragraph [0002] of the Specification.

OBJECTION TO THE DRAWINGS:

In the Office Action, at page 2, the Examiner objected to the Drawings for the reasons set forth therein.

Applicants respectfully submit that a monitor body (main body) 10 is shown in FIG. 1A submitted with the Amendment filed December 8, 2004, and accepted by the Examiner in the Office Action mailed February 24, 2005.

Accordingly, Applicants respectfully submit that no corrected drawing sheets are required, and that the objection is overcome.

CLAIM OBJECTION:

In the Office Action, at page 3, the Examiner objected to claim 23 for the reasons set forth therein.

Applicants respectfully submit that, as suggested by the Examiner, the amendment of claim 23 overcomes the Examiner's objection.

REJECTION UNDER 35 U.S.C. §112:

In the Office Action, at page 3, the Examiner rejected claims 1-39 under 35 U.S.C. §112, first paragraph for the reasons set forth therein. The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

MPEP 608.01(o) recites:

"[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the application should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification, *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901).

Applicants respectfully submit that one of ordinary skill in the art would understand that, as used in the Specification, the phrases "main body" and "monitor body" are interchangeable.

Accordingly, Applicants respectfully submit that the claimed subject matter is described in the Specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventors had possession of the claimed invention.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action, at page 2, the Examiner rejected claims 1-4, 30, and 38 under 35 U.S.C. §102(b) as being anticipated by Su et al., (US 6, 712,321 – hereinafter Su). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Su issued on March 30, 2004. The subject application was filed on September 29, 2003. Applicants respectfully submit that March 30, 2004 is not more than one year prior to September 29, 2003.

Accordingly, Applicants respectfully submit that Su is not valid prior art under 35 U.S.C. §102(b).

Additionally, Su was filed in the United States on May 21, 2003. The subject application claims the priority benefit of US Provisional No. 60/413,776 filed September 27, 2002.

Accordingly, Applicants respectfully submit that Su is not valid prior art under any subsection of 35 U.S.C. §102.

In the Office Action, at page 6, the Examiner rejected claim 39 under 35 U.S.C. §102(b) as being anticipated by Hodge et al., (US 6, 062,148 – hereinafter Hodge). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

The MPEP states: “[t]o anticipate a claim, the reference must teach every element of the claim.” (MPEP 2131).

The MPEP then quotes: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Quoted in MPEP 2131).

The MPEP further quotes “[t]he elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). (Quoted in MPEP 2131).

Independent claim 39 recites: “...a base part; a guide rail extending from the base part; a slider, guided by the guide rail to translate thereon; a ball bearing unit provided between the guide rail and the slider; a body bracket to be fixedly coupled to a monitor body; a supporting bracket connected with the slider; a connecting assembly connected between the supporting bracket and the body bracket; and at least one spiral spring having an elasticity sufficient to support a weight of the monitor body, to extend and contract in response to a movement of the slider.”

Hodge discloses a counterbalance mechanism for a height adjustable worksurface 3. Leg assemblies 110 are connected to uprights 150 of base 40 via outer rails 116, and are connected to bracket 2 via bracket 111. (See Hodge, at col. 11, lines 20-41). Drive shaft 4 is mounted on bracket 2 and is operably connected to worksurface 3. (See Hodge, at col. 5, lines 1-5).

Outer ball bearings 18 are disposed between inner rail 114 and intermediate rail 115. And inner ball bearings 117 are disposed between intermediate rail 115 and outer rail 116, which is fixed to upright 150. The ball bearings 117 and 118 are disposed entirely within leg assembly 110.

Accordingly, contrary to the Examiner’s assertion, ball bearing unit 118 is not provided between upright 150 and leg assembly 110. (See Hodge, at FIGS. 19-22, and col. 11, lines 20-42).

Further, the Examiner has provided no evidence to support the assertion that in Hodge, cover 131 is connected between bracket 2 and worksurface 3. Instead, bracket 2 appears to be connected directly to worksurface 3, and cover 131, which appears to surround bracket 2, also appears to be directly connected to worksurface 3. Indeed, leg assemblies 110 (which appear to

be unclearly referred to as legs 32 and 33 – legs 32 and 33 are not shown in the drawings) appear to fit through openings 149 in the cover 131. (See Hodge, at FIGS. 1, 2, and 24, col. 5, lines 1-5, and col. 12, lines 54-57).

Accordingly, Applicants respectfully submit that Hodge fails to disclose every element of the claims, arranged as required by the claims, and thus, the Examiner has not provided sufficient evidence to maintain a prima facie anticipation rejection of claim 39.

CONCLUSION:

In accordance with the foregoing, Applicants respectfully submit that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

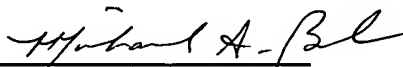
If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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